

## **REMARKS**

Claims 1-14 are pending in the application. Claims 1-14 stand rejected.

Claims 1, 2, 13, 14 have been amended in this Response. Claims 15-19 have been added. No new matter has been added. Applicant respectfully requests reconsideration of the pending claims in light of these amendments and the following remarks.

### **I. The 101 Rejection**

Claims 13 and 14 stand rejected under 35 U.S.C. § 101 as being unpatentable because the claimed invention is directed to non-statutory subject matter. Claims 13 and 14 have been amended to clarify patentable subject matter. Claim 13 has been amended to recite:

“A method of providing to a user a ranking of elements from an online catalog according to a user-specified criteria comprising:  
receiving at a server engine which is part of a computer system a request from the user regarding two or more elements in the online catalog, the request including one or more user requirements;  
retrieving information about each of the elements;  
determining if each element is simple;  
if an element is not simple, then obtaining advisory input about the not-simple element from an advisory module;  
determining if the pricing of each element is simple;  
if the pricing of an element is not simple, then obtaining pricing input about the not-simple pricing from a pricing module;  
using a correlation engine in the computer system, evaluating the elements as to the extent that each of the elements meet the user requirements and ranking the elements accordingly; and  
using the computer system, presenting the user with a list of elements that are ranked according to how the elements satisfy the user requirements in the request from the user.”

No new matter has been added, the additional limitations of a server engine and a computer system being present in the application as filed, for example in Claims 1 and 2

respectively. Support for the additional limitation relating to “user requirements” can be found in the specification as filed at page 12, lines 5-7. The presentation made to the user using the computer system of a “list of elements that are ranked according to how the elements satisfy the preference information and the user requirements in the request from the user” is a concrete, useful and tangible result that is believed to satisfy the statute. Accordingly, Claim 13 as amended is now considered to be in condition for allowance and reconsideration is respectfully requested.

Similarly, Claim 14 has been amended to recite:

“A method of providing to a user a ranking of elements from an online catalog according to a user-specified criteria comprising:  
receiving at a server engine a request from the user regarding two or more elements in the online catalog, the request including one or more user requirements;  
retrieving information about each of the elements;  
determining if each element is simple;  
if an element is not simple, then obtaining advisory input about the not-simple element from an advisory module;  
determining if the pricing of each element is simple;  
if the pricing of an element is not simple, then obtaining pricing input about the not-simple pricing from a pricing module;  
prompting the user to input additional preference information based upon the advisory input and the pricing input;  
using the computer system, presenting the user with a list of elements that are ranked according to how the elements satisfy the preference information and the user requirements in the request from the user.”

No new matter has been added, the additional limitations of a server engine and a computer system being present in the application as filed, for example in claims 1 and 2 respectively. Support for the additional limitation relating to “user requirements” can be found in the specification as filed at page 12, lines 5-7. The presentation made to the user using the computer system of a “list of elements that are ranked according to how the elements satisfy the

preference information and the user requirements in the request from the user” is a concrete, useful and tangible result that is believed to satisfy the statute. Accordingly, Claim 14 as amended is now considered to be in condition for allowance and reconsideration is respectfully requested.

## **II. The §103 Rejection**

Claims 1-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Henson (U.S. Patent No. 6,167,383) in view of Greef et al (“Greef”), US Patent No. 6,032,129.

Claim 1 has been amended to recite:

“An apparatus that provides quantitative and qualitative recommended selections to a user as the result of a request having user requirements inputted by the user, said apparatus comprising:

a server engine, said server engine constructed and arranged to accept requests having one or more user requirements from the user and send a response having one or more recommended selections responsive to the user requirements thereto;  
a pricing database, said pricing database constructed and arranged to store pricing information and to retrieve pricing information;

an advisor database, said advisor database constructed and arranged to store advisor information and to retrieve advisor information;

a catalog database, said catalog database constructed and arranged to store product information and to retrieve product information;

a content relationship manager, said content relationship manager constructed and arranged to store and to retrieve client relationship data;

a correlation engine;

a pricing function module operatively connected to said pricing database and said correlation engine;

an advisor function module operatively connected to said advisor database and said correlation engine;

a catalog module operatively connected to said catalog database and said correlation engine; and a correlation engine database operatively connected to

said correlation engine, said correlation engine database constructed and arranged to store a result of said correlation engine and requests from said user;

wherein when said user submits the request having one or more user requirements to said server engine, said server engine forwards said request to said correlation engine, said correlation engine therein retrieves pricing information from said pricing database through said pricing function module, advisory information from said advisor database through said advisor function module, catalog information from said catalog database through said catalog module and correlates all of said information to form said response having one or more recommended selections responsive to the user requirement or user requirements to said user.

No new matter has been added, as support for the additional limitation relating to “user requirements” can be found in the specification as filed at page 12, lines 5-7.

**Henson** discloses “a system configuration options screen **70**” with which “a customer of the online store **10** can build a customer configured machine by selecting from options listed on the configuration screen **70**.” (**Henson** at col. 6, lines 18-21.) “The configurator of the prior [to **Henson**] online store would present to the user the system selected off from the welcome page and include all available options. The smartness of the prior system was in describing the choices for the system which the customer had selected. The present online store takes into account that some choices are not as right as others.” (**Henson** at col. 5, lines 37-40, emphasis added).

Thus the recommended selections of both the prior online service and present online store of **Henson** are options responsive to the product first selected by the customer, that initial selection being made by the customer from the welcome page of **Henson** without, it appears, the help of the configurator. Thus **Henson** does not disclose “recommended selections responsive to the user requirements” inputted by the user in a request as recited by Claim 1. In **Henson**, the customer has to make the first selection of the base machine and then additional information is provided responsive to that selection.

Similarly, the “long lead time warning” disclosed by **Henson** is provided “upon”, or responsive to, a customer “selection of a system option...” (see **Henson** at col. 6, lines 44-51), thus the warning is not a “recommended selection responsive to the user requirements,” but

rather is responsive to a customer product (or option) selection. Similarly, the merchandising recommendations of Henson may “enable specific messaging to be called in response to the particular choices being made by the customer during the configuring of a custom computer system.” (Henson col. 7, lines 32-36, emphasis added.) Once again, **Henson** discloses information being provided in response to customer product choices, not in response to customer requirements that can be met by “one or more recommended selections,” as recited by Claim 1.

**Greef** does not appear to satisfy this deficiency of Henson. **Greef** appears to disclose an “electronic catalog system” for shopping ”by first facilitating the creation of customer-personas and their catalog-content affinities..., secondly facilitating the persona associated based configuration of a “Customer-Actor” by the actual Shopper and thirdly by commissioning an allowing the creation of an “on the desktop” computer directed sales-advisor-agent by the Shopper that generates advise on catalog navigation, product applications and product functions that is tuned to the proxy customer’s configured personality and specific needs.” (**Greef** at col. 2, lines 39-47) **Greef** requires the customer to configure the:

“Customer-Actor by persona association 206. This is a numeric strength specifying the similarity (association) between the customer agent and the customer personas. For example, the agent can behave 60% like Star Trek <sup>TM</sup>’s CAPITAN PICARD <sup>TM</sup> persona, 20% like CAPTAIN KIRK <sup>TM</sup> persona, and 20% like Mr. SPOCK <sup>TM</sup> persona. This will configure a customer actor 206 that is sophisticated enough to drink EARL GRAY <sup>TM</sup> tea, has a fairly strong attraction for members of the opposite sex and is pretty rational and logical enough when making shopping decisions.”

**Greef** at col, 4, lines 37 – 47. **Greef** does not explain how the Customer-Actor knows to use the PICARD beverage preference, the KIRK romantic appeal and the MR. SPOCK shopping preference rather than, say, the MR. SPOCK romantic appeal, the KIRK beverage preference and PICARD shopping style, but setting that aside, the advice offered is of necessity in **Greef** predicated on the assumed affinities or preferences of the Customer-Actor configured by the customer using the persona associations, because the sales representative has assigned “Affinities between the customer personas and the content in the catalog 204.” **Greef** at col, 4, lines 15-16. Thus the advice in **Greef** is based on perceived similarities between the customer and the

Customer-Actor and the Customer-Actor's affinities for the catalog items, rather than being provided based directly on "user requirements" as in the instant Claim 1.

Accordingly, Claim 1 as amended is believed to be patentably distinguishable over these references and be in condition for allowance. Reconsideration is respectfully requested.

Similarly, claim 2 has been amended to recite:

A computer system comprising:

a server engine, the server engine constructed and arranged to accept requests

having one or more user requirements from a client device;

a correlation engine operative with the server engine;

a pricing function module operative with the correlation engine;

an advisor function module operative with the correlation engine;

a catalog operative with the correlation engine;

wherein upon receiving a the request having one or more user requirements from the client device via the server engine, the correlation engine references the pricing function module, the advisor function module, and the catalog to formulate a response to the request by ranking one or more items within the response according to one or more user requirements within the request.

No new matter has been added, as support for the additional limitation relating to "user requirements" can be found in the specification as filed at page 12, lines 5-7.

The combination of **Henson** and **Greef** does not appear to meet the limitation of formulating "a response to the request by ranking one or more items within the response according to one or more user requirements" as opposed to responsive to a customer product selection or customer-generated Customer-Actor affinity. Accordingly, Claim 2 as amended is believed to be patentably distinguishable over these references and be in condition for allowance. Reconsideration is respectfully requested.

Claims 3-12 depend directly or indirectly on Claim 2 and contain all of its limitations as amended. Accordingly, Claims 3-12 are believed to be patentably distinguishable over **Henson** and **Greef** and are believed to be in condition for allowance. Reconsideration is respectfully requested.

Like Claim 1, Claims 13 has been amended to contain a limitation that the request include “one or more user requirements;” and a limitation that “using the computer system, presenting the user with a list of elements that are ranked according to the advisory input and the pricing input and that how the elements satisfy the user requirements in the request from the user.” The combination of **Henson** and **Greef** does not appear to meet these limitations. Accordingly, Claim 13 as amended is believed to be patentably distinguishable over these references and be in condition for allowance. Reconsideration is respectfully requested.

Similarly, Claim 14 has been amended to contain a limitation that the request include “one or more user requirements;” and a limitation that “using the computer system, presenting the user with a list of elements that are ranked according to the advisory input and the pricing input and that how the elements satisfy the preference information and the user requirements in the request from the user.” The combination of **Henson** and **Greef** does not appear to meet these limitations. Accordingly, Claim 14 as amended is believed to be patentably distinguishable over these references and be in condition for allowance. Reconsideration is respectfully requested.

### **III. New Claims**

Claims 15-19 have been added. No new matter has been added. Support for claim 15 can be found in Claim 1 as filed and in the specification as filed, for example at paragraph 0023 (where services as well as products are mentioned). Claims 16-19 depend from Claim 15. Support for the additional limitations of Claim 16 and Claim 17 can be found in paragraph 0018 of the instant application as filed. Support for the additional limitation of Claim 18 can be found in claim 2 as filed. Support for the additional limitation of Claim 19 can be found in paragraph 0026 of the specification as filed.

For the reasons described with respect to Claim 1, Claim 15 is believed to be patentably distinguishable over **Henson** and **Greef** and be in condition for allowance. Reconsideration is respectfully requested. Claims 16-19 depend from Claim 15 directly or indirectly and contain all of its limitations. Thus Claims 16-19 are believed to be in condition for allowance. Consideration is respectfully requested.

## CONCLUSION

Applicants respectfully request reconsideration of this application and allowance of its pending and new claims in light of the above amendments and remarks.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Danita J. M. Maseles", written in a cursive style.

Danita J. M. Maseles  
Reg. 33,419

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Enclosures:

1. Petition for Revival of an Application for Patent Abandoned Unintentionally Under CFR1.137(b)
2. Fee Transmittal and Authorization to Charge Deposit Account (in duplicate).
3. Certificate of Mailing
4. Acknowledgment Postcard